



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,147	05/30/2001	Toshiaki Tsuboi	10746/26	8853
26646	7590	01/10/2008	EXAMINER	
KENYON & KENYON LLP			PASS, NATALIE	
ONE BROADWAY			ART UNIT	
NEW YORK, NY 10004			PAPER NUMBER	
			3626	
			MAIL DATE	DELIVERY MODE
			01/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/870,147	Applicant(s) TSUBOI ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13, 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 October 2007. Claims 1, 5, 9, 13 and 17 have been amended. Claims 6 and 14 have been cancelled. Claims 1-5, 7-13, 15-17 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7, 9-11, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 and Joao, U.S. Patent Application Publication Number 2001/0032099 for substantially the same reasons given in the previous Office Action (paper number 20070628). Further reasons appear hereinbelow.

(A) Claim 17 has been amended to recite

- storing scenarios each of which is standardized and includes a target lifestyle, a level of readiness for change, standardized health promotion timing, and standardized health promotion information corresponding to said level of readiness for change and corresponding to said standardized health promotion timing;

- obtaining data on lifestyles and said level of readiness for change of a client;
- generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing;
- storing said health promotion schedule;
- unfolding a schedule by reading a stored health promotion schedule and generating a calendar indicating said health promotion scheduled date and display said calendar on a display part of said health promotion practitioner support apparatus or on a terminal which can access said health promotion practitioner support apparatus; and
- outputting said health promotion information corresponding to said health promotion scheduled date selected by a health promotion practitioner on said calendar.

As per these new limitations, Strecher and Joao teach a method as analyzed and discussed in the previous Office Action (paper number 20070628) further comprising

storing scenarios each of which is standardized (Joao; Figure 15A, Item 1505, paragraphs [0049], [0310], page 28, claim 17) and includes “increased longevity or enhancement of quality of life” and “a specific behavior change goal” (reads on “a target lifestyle”) (Strecher; column 2, lines 25-52), “motives to changing the health related behavior” (reads on “a level of readiness for change”) (Strecher; column 2, lines 45-52, column 4, lines 22-26), standardized health promotion timing, and standardized health promotion information

corresponding to said level of readiness for change and corresponding to said standardized health promotion timing (Strecher; column 2, lines 54-62); Examiner interprets Strecher's teachings of "[u]sing these data, the computer algorithm produces ... [...] ... single month calendar sheets or a series of date book pages ... [...] ... preferably include at least the months relevant to the health-related behavior change phases of the user. These calendar or date book sheets can be provided to the user at the same time or sequentially over the actual months of the year" and "specific instructions and advice ... [...] ... health-related behavior" (Strecher; column 2, line 63 to column 3, line 4) to teach a form of "standardized health promotion timing, and standardized health promotion information corresponding to said level of readiness for change and corresponding to said standardized health promotion timing;"

"collecting" or "gathering" (reads on "obtaining") data on lifestyles (Strecher; column 2, lines 12-30) and said level of readiness for change of a client (Strecher; column 4, lines 22-26); Examiner interprets Strecher's teachings of "[d]uring the preparation phase, motives cited by the user are also analyzed and incorporated into the algorithm, which provides instructions intended to internalize motives for changing" as teaching obtaining data on said level of readiness for change of a client;

generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing (Strecher; column 2, line 25 to column 3, line 4); Examiner interprets Strecher's teachings of "[u]sing these data, the computer algorithm produces [reads on "generates"] ... [...] ... single

month calendar sheets or a series of date book pages ... [...] ... preferably include at least the months relevant to the health-related behavior change phases of the user. These calendar or date book sheets can be provided to the user at the same time or sequentially over the actual months of the year” and “specific instructions and advice ... [...] ... health-related behavior” (Strecher; column 2, line 63 to column 3, line 4) to teach a form of “generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing;”

storing said health promotion schedule (Strecher; column 3, lines 5-12, column 3, line 61 to column 4, line 3);

unfolding a schedule by reading a stored health promotion schedule and generating a calendar indicating said health promotion scheduled date and display said calendar on a display part of said health promotion practitioner support apparatus or on a terminal which can access said health promotion practitioner support apparatus (Strecher; column 2, line 54 to column 3, line 12, column 3, line 61 to column 4, line 3); Examiner interprets Strecher’s teachings of “[u]sing these data, the computer algorithm produces feedback, for example, in the form of single month calendar sheets or a series of date book pages ... [...] ... contain specific instructions and advice associated with the history and patterns of the existing health-related behavior, motives to changing the health related behavior, the behavior change goal set, the specified dates for beginning the change, the phases of change, and barriers to changing the

health-related behavior” (Strecher; column 2, line 54 to column 3, line 1) to teach a form of this limitation; and

outputting said health promotion information corresponding to said health promotion scheduled date selected by a health promotion practitioner on said calendar (Strecher; column 2, line 54 to column 3, line 12, column 3, line 61 to column 4, line 3).

The remainder of claim 17 is rejected for the same reasons given in the prior Office Action (paper number 20070628, section 4, pages 2-6), and incorporated herein.

The motivations for combining the respective teachings of Strecher and Joao are as given in the rejection of claim 17 in the prior Office Action (paper number 20070628) and incorporated herein.

(B) Claims 2-3, 7, 10-11, and 15 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070628, section 4, pages 2-8), and incorporated herein.

(C) Apparatus claim 1 repeats the subject matter of claim 17, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 17 have been shown to be obvious in view of the teachings of Strecher and Joao in the above rejections of claim 17, it is readily apparent that the system disclosed by Strecher and Joao includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 17, and incorporated herein.

(D) Claim 9 differs from method claim 1 by reciting a “computer readable medium having a program executable by a processor...” in the preamble. As per this limitation, Strecher clearly discloses his invention to be implemented on a “computer readable medium having a program executable by a processor...” (Strecher; column 2, line 63 to column 3, line 4). The remainder of claim 9 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of Strecher and Joao are as given in the rejection of claim 17 in the prior Office Action (paper number 20070628) and incorporated herein.

4. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 and Joao, U.S. Patent Application Publication Number 2001/0032099, as applied to claims 1 and 9 above, and further in view of Rieger et al. article: “Development of an Instrument To Assess Readiness to Recover in Anorexia Nervosa.” 2000. URL: <<http://www3.interscience.wiley.com/cgi-bin/fulltext/74000261/PDFSTART>>, hereinafter known as Rieger, for substantially the same reasons given in the previous Office Action (paper number 20070628). Further reasons appear hereinbelow.

(A) Claims 4 and 12 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070628, section 5, pages 8-9), and incorporated herein.

5. Claims 5, 8, 13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 and Joao, U.S. Patent Application Publication Number 2001/0032099, as applied to claims 1 and 9 above, and further in view of Douglass et al., U.S. Patent Number 6, 039, 688, for substantially the same reasons given in the previous Office Action (paper number 20070628). Further reasons appear hereinbelow.

(A) The amendments to claims 5 and 13 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

(B) Claims 8 and 16 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070628, section 6, pages 9-11), and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 19 October 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 19 October 2007.

(A) As per Applicant's argument in page 9 of the 19 October 2007 response that the Strecher reference fails to disclose "generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of

readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing,” as recited in amended claim 1, Examiner respectfully disagrees. Examiner interprets Strecher’s teachings of “the invention uses health risk and psychosocial information collected from the user of the process. This information is then preferably entered into a computer algorithm that uses the information to create tailored behavior change and adherence feedback” and “using these data, the computer algorithm produces [reads on “generates”] ... [...] ... single month calendar sheets or a series of date book pages ... [...] ... preferably include at least the months relevant to the health-related behavior change phases of the user. These calendar or date book sheets can be provided to the user at the same time or sequentially over the actual months of the year” (Strecher; column 2, line 63 to column 3, line 4) and Strecher’s teachings of “the monthly calendar or date book sheets contain specific instructions and advice associated with the history and patterns of the existing health-related behavior, motives to changing the health related behavior, the behavior change goal set, the specified dates for beginning the change, the phases of change, and barriers to changing the health-related behavior” (Strecher; column 2, line 40 to column 3, line 12) as teaching a form of “generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing.”

Further, Examiner respectfully notes that although it was the combined teachings of Strecher and Joao that were applied in the rejection of claim 1 under 35 USC § 103, Applicant

analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's implied assertions in page10-11 of the 19 October 2007 response that there is no suggestion to combine the references and that a *prima facie* case of obviousness has not been established, the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, the motivations explicitly stated at the paragraph bridging pages 5-6 of the previous office action (paper number 20070628) (i.e., " ... with the motivations of providing a "method for processing and/or for providing healthcare information ... [...] ... information will be provided, in a uniform manner, to a next or different provider..." (Joao; paragraph [0002]), [0005]), and at the first paragraph of page 9 above (i.e., " ... with the motivation of increasing the effectiveness of interventions ...") (Rieger; page 395, paragraph 4, page 388, paragraph 4).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to

one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited. Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

January 7, 2008



C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600